

5W



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,041	02/15/2002	Max Stern	STN.0108	1910
30733	7590	01/10/2005	EXAMINER	
Jeffrey C. Maynard 154 Barbara Road Severna Park, MD 21146			BROCKETTI, JULIE K	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

<b>Office Action Summary</b>	Application N .	Applicant(s)	
	10/077,041	STERN, MAX	
	Examin r	Art Unit	
	Julie K Brockett	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 November 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4,6,7 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,7 and 14-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 5, 2004 has been entered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-4, 6, 7, 14, 16, 17 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Travis et al., U.S. Patent No. 5,380,007 in view of the DC Lottery's "DC Lucky Numbers".** Travis et al. discloses a gaming device and method for playing a game. The game is a slot machine and includes game initiating means to initiate a game on the machine (col. 2 lines 7-9). A display means is disposed to display the game being played on the

machine. The display means is arranged to display a plurality of elements having indicia each associated with a symbol. The machine further includes buttons indicating grid reference on the display so that indicia positions may be selected by pressing the buttons (Fig. 4; col. 2 lines 3-5; col. 3 lines 41-50). The display is an electromechanical device (Fig. 1; col. 2 lines 32-34). The game has a game controller, which provides a first set of contest elements having a surface area with playing indicia on the surface area. The game controller displays all elements of a first set of contest elements to a player of the game. The player is then permitted to select a plurality of elements from the first set of contest elements for game play, wherein the quantity of elements selected corresponds to the number of elements for matching (col. 2 lines 3-5). A table of values is established for matching the selected contest elements based on the number of elements selected (col. 3 lines 51-54). The controller then provides a sufficient number of additional sets of contest elements. The additional number of sets is equal to the number of elements selected by the player for play of the game and each additional set is identical to the first set of elements. The controller then randomly selects one element from each of the additional sets of elements and compares the randomly selected elements to a user selected contest elements obtained. The controller then evaluates the number of matched contest elements selected by the player against the table of values (Fig. 3; col. 7 lines 23-41). The number of contest elements in the first set is at least ten and the player selects at least two elements from the first set

of contest elements. The player selects no more than eight elements from the first set of contest elements (Fig. 1). The game controller is an electronic video game machine, i.e. a computer. Players may place a wager on each possible matching outcome. If the player has a winning combination of contest elements as determined by the table of values according to the player's wager, the player is paid an award. The game has an electronic system for playing a slot machine game and has a plurality of play options wherein a win or a loss is determined after each play of the game. The system includes a game enclosure, including a player interface means for a player to physically interact with the system. A bet value entry means is used for generating a bet value signal to the system representing an amount of a bet placed by a player (col. 4 lines 35-50). Player display means visually indicates to the player a set of elements having indicia thereon. Player selection means allows the player to select a plurality of elements from the set of elements (col. 4 lines 53-55). A game control means is responsive to the player selection means wherein control means randomly selects from the set of elements having indicia thereon equal to a number of elements (Fig. 1). A processor compares the indicia on the player selected elements to the indicia on the randomly selected elements and awards a prize to the player in the event that one or more of the user selected elements matches the randomly selected elements (Fig. 6). The processor means is electrically connected to the player display means, the player selection means, the bet value entry means and to the game control

means (Fig. 1). Travis et al. discloses all of the limitations mentioned above including that the game controller is an electronic video game machine, i.e. a computer. It would have been obvious at the time the invention was made that the game controller can be selected from the group consisting of electronic video game machines, mechanical game machines, computers, hand-held mechanical devices and hand-held video devices. All of these types of machines are well known in the art and are capable of implementing the game method described in Travis et al. It is up to the inventor's discretion which game machine to use. Players enjoy all types of gaming machines and by implanting the method of Travis et al. on various machines; more players would be interested in the game.

Travis lacks in disclosing that the player select the style of the game including matching elements IN ORDER, in DISORDER or a COMBINATION of matching elements in order and in disorder. The DC Lottery's game "DC Lucky Numbers" allows players to select the style of a game for matching contest elements, i.e. numbers. The style is selected from the group consisting of matching elements IN ORDER; matching elements in DISORDER and a COMBINATION of elements in ORDER and DISORDER. A player places a wager on each possible matching outcome according to the style of the game selected. A table of values is established for a plurality of elements based on the selected contest numbers, the number of elements selected and the style of the game selected (See "DC Lucky Numbers"). For example, a player may select

Art Unit: 3713

the style of game to play, either straight (IN ORDER), box (DISORDER), straight/box, combo, front pair (COMBINATION) or back pair (COMBINATION) and are awarded different amounts based on which game style they selected to play. The player may repeat the selection of any element as often as desired up to the limit of the number of elements to be selected only if the style of game is to match elements IN ORDER. For example, the player may wish to play more than one game using an Advance Play feature wherein their bet is repeated. It is obvious that the number of wagers could be equal to the number of elements selected when the style of game is to match elements IN ORDER, the number of wagers could be equal to one or more than the number of elements selected when the style of game is to match elements in DISORDER and the number of wagers could be equal to two or more than the number of elements selected when the style of game is to match elements in COMBINED. DC Lottery teaches of a variety of wagering styles and it would have been obvious to one of ordinary skill in the art to implement any type of wagering style that is profitable to lottery. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the game styles and wagering of "DC Lucky Numbers" into the lottery gaming device of Travis. Lottery players enjoy selecting their numbers and the types of combinations that are winners, i.e. straight, box, etc. Therefore, by allowing the gaming players of Travis to select the style of the game they wish to play,

players would have a more enjoyable gaming experience because they have more control over what types of combinations they are wagering on.

**Claims 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Travis et al., in view of “DC Lucky Numbers” in further view of Morro et al., U.S. Patent No. 5,947,820.** Travis et al. lacks in disclosing a touch sensitive screen and a set of rotatable reels. Morro et al. discloses an electronic game in which the display means comprises a touch sensitive video screen and the player selects indicia by touching areas on the screen in which the indicia are displayed (See Morro et al. col. 3 lines 43-48). The display means further comprises a set of rotatable reels (See Morro et al. Fig. 2). It would have been obvious at the time the invention was made to use a touch screen display in the invention of Travis et al. Touch screens are well known in the art and allow the player to directly touch the item they wish to select. It simplifies the selection process for the player and they do not need to learn how various buttons operate. It would also have been obvious at the time the invention was made to use rotatable reels in the invention of Travis et al. Many games use rotatable reels to simulate the selection of a random number or symbol. Players have enjoyed games with rotatable reels throughout the years and it is obvious to implement this display method in Travis et al. in order to appeal to those players who enjoy rotatable reel games.

***Response to Amendment***



It has been noted that claims 1, 14, 19 and 21 have been amended.

The Examiner also notes that the status identifier of claim 21 is incorrect and it should be "currently amended". Claims 5 and 8-13 have been cancelled.

### ***Response to Arguments***

Applicant's arguments filed November 5, 2004 have been fully considered but they are not persuasive.

Applicant argues that nothing in Travis et al. teaches or even suggests that a player can select the style of game being played including matching elements IN ORDER, in DISORDER or a COMBINATION of elements in DISORDER and IN ORDER. The Examiner agrees that Travis does not teach this limitation and the reference DC Lottery has been applied to teach this limitation. Contrary to Applicant's assertion. DC Lottery is not an unrelated reference in that it is a lottery game which is the same field of art as the Travis reference.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941

(Fed. Cir. 1992). In this case, one would be motivated to combine Travis and DC Lottery so that the invention of players of the Travis game could have more game options including a variety of game styles. Lottery players enjoy selecting their numbers and the types of combinations that are winners, i.e. straight, box, etc. Therefore, by allowing the gaming players of Travis to select the style of the game they wish to play, players would have a more enjoyable gaming experience because they have more control over what types of combinations they are wagering on. This is general knowledge in the art that players want to play games that interest them and that they find enjoyable.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that DISORDER provides for a win for matching less than all elements in a different position; that COMBINATION provides an extra win for, not only matching all the selected elements, but for matching all the elements IN ORDER) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Examiner notes that the terms "DISORDER" and "COMBINATION" are vague terms and various arrangements can be considered to include "disorder" or "combinations". Consequently, the claims are given their


broadest reasonable interpretations and the combination of Travis in view of DC Lottery read on every limitation of the claims.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K Brockett whose telephone number is 571-272-4432. The examiner can normally be reached on M-Th 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Julie K Brockett  
Examiner  
Art Unit 3713